

PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of

Jack David HAMMOND, et al.

Appln. No.: 09/807,608

Confirmation No.: not yet assigned

Filed: April 16, 2001

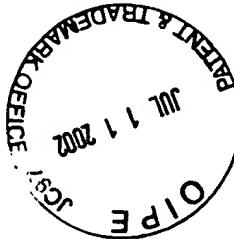
For: A PARKING MANAGEMENT SYSTEM

Docket No: Q63675

PCT/AU99/00891

Group Art Unit: not yet assigned

Examiner: B Tung



ATTN: PCT LEGAL OFFICE

Commissioner for Patents
Washington, D.C. 20231

Sir:

In the Decision on Petition mailed January 11, 2002 the petition was dismissed without prejudice on the grounds that insufficient factual proof was provided that the missing joint inventor refused to join in the application.

Reconsideration and granting of the Petition Under 37 C.F.R. § 1.47(a) is respectfully requested in view of the additional Declaration of Facts in Support of Petition Under 37 C.F.R. § 1.47(a) submitted herewith along with supporting exhibits H-N.

While Mr. Gockel has not specifically refused to sign he has effectively refused to sign in spite of various deadlines set for him to do so. Thus it is submitted that the actions of Mr. Gockel clearly constitute a refusal to sign. Therefore it is respectfully requested that the Petition be granted.

Renewed Petition Under 37 C.F.R. § 1.47(a)
USSN 09/807,608
PCT/AU99/00891
Attorney Docket Q63675

As stated in the Decision on Petition no additional petition fee is required for the renewed petition. A four month extension of time fee for a small entity is submitted herewith.

Respectfully submitted,



Robert V. Sloan
Registration No. 22,775

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Date: July 11, 2002

PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of

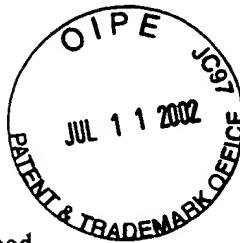
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DECLARATION OF FACTS IN SUPPORT OF PETITION UNDER 37.C.F.R § 1.47(a)

Commissioner for Patents
Washington, D.C., 20231

Sir:

I, Michael Lindsay Craig, a named co-inventor in the above identified application and a Director of the assignee company, Aptos Corporation Pty. Ltd. ("the company"), do hereby declare that I was the person responsible for trying to obtain the signature of Andrew Rainer Gockel on the Declaration for the above identified application. I made a Declaration on 19 December 2001, setting out facts in support of a Petition under 37.C.F.R § 1.47(a) ("the earlier Declaration"). The earlier Declaration was filed on 26 December 2001 and this Declaration is supplemental to the earlier Declaration.

Since the earlier Declaration was filed, I have again forwarded documents to Mr Gockel for his signature. These documents included Assignment and Declaration and Power of Attorney documents and a full copy of the specification and were forwarded to Mr Gockel with a letter dated 22 April 2002. A copy of the letter of 22 April 2002 and the documents enclosed with that letter is attached as Exhibit "H". The full copy of the specification enclosed with the letter of 22 April 2002 included the drawings, description and claims. The specification forwarded to Mr Gockel with our letter of 11 September 2001 (referred to in the earlier Declaration) also included the drawings, description and claims.

Mr Gockel is a shareholder of the company. By virtue of an assignment deed signed by Mr Gockel and the other inventors on 30 March 1998, Mr Gockel has assigned his interest in the invention to the company.

In my letter of 22 April 2002 to Mr Gockel, I requested Mr Gockel to sign the Assignment and Declaration and Power of Attorney documents enclosed with that letter and to return the

signed documents to the office of the company by 15 May 2002. In that letter, I also stated to Mr Gockel that "should you not intend to sign the documents and neither advise us of that intention nor return the signed documents to us by 15 May 2002, we shall take it that you have refused to sign the said documents". The company did not receive the signed documents from Mr Gockel by 15 May 2002.

On 16 May 2002, I received a letter by facsimile from Mr Gockel and a copy of this letter is attached as Exhibit "I". In Mr Gockel's letter of 16 May 2002, Mr Gockel acknowledged receipt of my letter of 22 April 2002 and stated that he would need further time to review what he had received.

On 22 May 2002, I received an e-mail from Mr Gockel and a copy of this e-mail is attached as Exhibit "J". In this e-mail, Mr Gockel stated that he was still reviewing the Patent Application.

On 23 May 2002, Arthur Thomas Hallett, a Director of the company and co-inventor, replied by e-mail to Mr Gockel's e-mail of 22 May 2002. Mr Hallett provided to me a copy of his e-mail to Mr Gockel and a copy of this e-mail is attached as Exhibit "K".

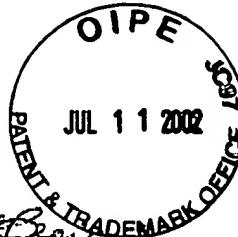
On 23 May 2002, Mr Hallett received an e-mail from Mr Gockel in reply to Mr Hallett's e-mail of 23 May 2002. Mr Hallett provided to me a copy of Mr Gockel's e-mail of 23 May 2002, and a copy of this is attached as Exhibit "L". In Mr Gockel's e-mail of 23 May 2002, he says that "I have given no indication that I will not sign these documents". Despite this, Mr Gockel continues to fail to sign and return the Declaration and Power of Attorney documents.

On 24 May 2002, I forwarded a letter to Mr Gockel by facsimile to a home facsimile number at which he had previously received correspondence and by mail to Mr Gockel's solicitor, Christopher Conley, and a copy of this letter is attached as Exhibit "M". A copy of a facsimile journal is attached as Exhibit "N", which shows that the facsimile to Mr Gockel was successfully transmitted on 24 May 2002. I telephoned the office of Morgan Conley, Mr Gockel's solicitors on 3 July 2002 to confirm that Mr Gockel had been forwarded the mailed copy of the letter of 24 May 2002. I was informed by Christopher Conley's secretary, Pia, that the letter of 24 May 2002 had been forwarded to Mr Gockel with a covering letter to him on 31 May 2002. In the letter of 24 May 2002 to Mr Gockel, I again requested Mr Gockel to sign and return the application documents. Additionally, I stated that "should you not return the signed documents to us by Friday 31 May 2002, we shall take it that you have refused to sign the said documents." In case Mr Gockel was concerned about any cost involved in signing and returning the application documents, I made an offer for the company to pay his reasonable expenses in doing so.

The company has not received a reply from Mr Gockel following the letter sent to him on 24 May 2002. The Assignment and Declaration and Power of Attorney forms forwarded to Mr Gockel with our letter of 22 April 2002 were not returned to the company by 31 May 2002, nor have they have been received since that date. I consider Mr Gockel's lack of reply and failure to return the signed documents as a refusal to sign the Assignment and Declaration and Power of Attorney documents.



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Respectfully, submitted,

By: Richard G. SmithTitle: DIRECTOR

APTO'S CORPORATION Pty Ltd
Co-APPLICANT

BEFORE ME:

10 JULY 2002

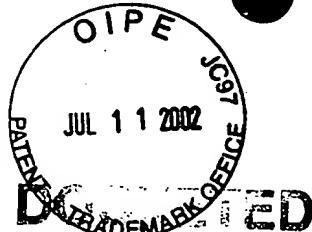
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within the meaning of the
Patent Act 1990



JAN 11 2002

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
Washington, D.C. 20231
www.uspto.gov



JAN 17 2002

Sughrue Mion, Zinn, Macpeak & Seas, PLLC
2100 Pennsylvania Avenue, N.W.
Washington, DC 20037

In re Application of HAMMOND et al
U.S. Application No.: 09/807,608
Int. Application No.: PCT/AU99/00891
Int. Filing Date: 15 October 1999
Priority Date: 16 October 1998
Attorney Docket No.: Q63675
For: A PARKING MANAGEMENT SYSTEM

DECISION ON PETITION

UNDER 37 CFR 1.47(a)

This is in response to applicants' "Petition Under 37 C.F.R. §1.47(a) and Submission of Executed Declaration, Added Pages and Declaration of Facts in Response to the Notification of Missing Requirements" filed 26 December 2001, requesting that the present application be accepted for United States national stage processing without the signature of one of the four joint inventors.

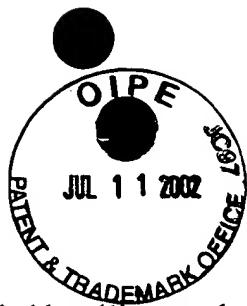
BACKGROUND

On 15 October 1999, applicants filed international application PCT/AU99/00891, which claimed priority of an earlier Australia application filed 16 October 1998. A copy of the international application was communicated to the USPTO from the International Bureau on 27 April 2000. A Demand for international preliminary examination, in which the United States was elected, was filed on 11 May 2000, prior to the expiration of nineteen months from the priority date. Accordingly, the thirty-month period for paying the basic national fee in the United States expired at midnight on 16 April 2001.

On 16 April 2001, applicants filed national stage papers with the United States Designated/Elected Office (DO/EO/US). The submission was accompanied by, *inter alia*, the basic national fee required by 35 U.S.C. 371(c)(1).

On 23 July 2001, the DO/EO/US mailed a Notification of Missing Requirements Under 35 U.S.C. 371 (Form PCT/DO/EO/905), which indicated that an oath or declaration in compliance with 37 CFR 1.497 must be filed along with a surcharge under 37 CFR 1.492(e) for providing the oath or declaration later than thirty (30) months from the priority date.

On 26 December 2001, applicants filed the present petition along with a declaration executed by three of the joint inventors and not executed by inventor Andrew Gockel.

DISCUSSION

A petition under 37 CFR 1.47(a) must be accompanied by: (1) an oath or declaration by each applicant on his or her own behalf and on behalf of the nonsigning joint inventors, (2) factual proof that the missing joint inventors refuse to join in the application or cannot be reached after diligent effort, (3) the fee set forth in §1.17(i), and (4) the last known addresses of the nonsigning joint inventors.

With regard to item (1) above, applicants have submitted a declaration signed by Jack Hammond, Michael Craig, and Arthur Hallett, each on his own behalf and on behalf of the nonsigning inventor Gockel.

With regard to item (2) above, MPEP 409.03(d) states in relevant part,

Where a refusal to sign the application papers is alleged, the circumstances of this refusal must be specified in an affidavit or declaration by the person to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted.

Before a refusal can be alleged, it must be demonstrated that a bona fide attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature. A copy of the application papers should be sent to the last known address of the nonsigning inventor, or, if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor's attorney.

When there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the affidavit or declaration. When there is an express written refusal, a copy of the document evidencing that refusal must be made part of the affidavit or declaration.

When it is concluded by the 37 CFR 1.47 applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which that conclusion is based should be stated in the affidavit or declaration. If there is documentary evidence to support facts alleged in the affidavit or declaration, such evidence should be submitted. Whenever a nonsigning inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the affidavit or declaration.

In the present case, applicants have not sufficiently established that a bona fide attempt was made to present a complete copy of the application papers (including specification, claims, drawings, and oath/declaration) to Gockel for signature. Although the affidavit of Michael Craig states that application papers were sent to Gockel on 11 September 2001 (see Craig's affidavit, pp.2-3), there is no evidence (e.g. a delivery confirmation receipt) that Gockel or his attorney actually received the communication. Furthermore, no details of any attempts to contact Gockel or his attorney by telephone to confirm receipt of the 11 September 2001 letter have been provided. Moreover, although the 11 September 2001 letter and Craig's affidavit state that the specification and declaration were sent to Gockel, there is no evidence that the claims and drawings were ever sent to Gockel. Therefore, it would be unreasonable to conclude at the present time that Gockel refuses to join in the application.

With regard to item (3) above, applicants have provided the requisite petition fee.

With regard to item (4) above, the petition states the last known address of the nonsigning inventor.

CONCLUSION

Because applicants have failed to satisfy item (2) above, the petition under 37 CFR 1.47(a) is DISMISSED without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Failure to timely file a proper response will result in abandonment of the application. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)". No additional petition fee is required. Extensions of time are available under 37 CFR 1.136(a).

Please direct further correspondence with respect to this matter to the Commissioner for Patents, Box PCT, Washington, D.C. 20231, and address the contents of the letter to the attention of the PCT Legal Office.


Bryan Tung
PCT Legal Examiner
PCT Legal Office

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